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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,696	07/09/2003	Andrew Desin	03-40054-US (883833.20001)	9697
7590	12/23/2004			EXAMINER
Reed Smith LLP 2500 One Liberty Place, 1650 Market St. Philadelphia, PA 19103-7301			SZEKELY, PETER A	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/615,696	DESIN, ANDREW 	
	Examiner Peter Szekely	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

#### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 26 March 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-37 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-37 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 09 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/15/03</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the subject matter of claims 26,33 and 34 cannot be found in the specification.
2. The disclosure is objected to because of the following: The identification of the anionic emulsifiers on page 8, paragraph 20 is incomprehensible.

Appropriate correction is required.

### ***Claim Objections***

3. Applicant is advised that should claim 1 be found allowable, claims 36 and 37 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The intended use does not differentiate the claim from another claim.

4. Claims 33 and 34 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The intended use does not further limit the claimed method.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The difference between resin and polymer is not understood by the examiner. Since the two words are synonyms and they are used interchangeably by people with ordinary skill in the art, the examiner will not state which material is the resin and which one is the polymer. If applicant had used the words in the British meaning, namely "resin" meaning rosin or other naturally occurring material like shellac and "polymer" meaning synthetic materials, applicant should specify the meanings as such to avoid confusion. Otherwise "first polymer" and "second polymer" should suffice. Appropriate correction is required. Furthermore, it is not known whether the compound applied in claims 28 and 32 is diluted or neat.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-22, 26, 27, 29-31 and 35-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Rostler 3,592,788, Woodruff 3,651,000, Green 4,268,428,

Blainpain et al. 4,997,868, Elias et al. 5,151,456, Batdorf et al. 5,330,795, Grubba 5,795,929 or Harlan 2002/0058734.

10. Rostler discloses applicant's emulsions in column 2, lines 18-44, concentrated and dilute emulsions in column 2, lines 9-17, spraying in the paragraph overlapping columns 1 and 2, mixture of emulsions in the Abstract, dilutions and application rates in column 6, lines 9-16. Woodruff teaches butadiene-styrene latex, polyethylene latex asphalt emulsion and emulsifiers in claims 1-4. Green recites asphalt emulsion, vinyl acrylic copolymer and Neoprene latex in claims 1-8. The latex contains PVOH emulsifier according to the paragraph overlapping columns 2 and 3. The customary emulsifier concentration of latices (1-5% by weight of solids) overlaps applicant's claimed concentration. Blainpain et al. divulge asphalt emulsion, poly(meth)acrylic acid, cationic surfactant and a latex in claim 4. Elias et al. reveal asphalt emulsion, rubber and emulsifier in claim 1, vinyl acetate latex in claim 20 and latex concentrations in column 8, lines 8-15. Batdorf et al. display applicant's compound in Examples 5, 9 and 10, emulsifiers in claim 1, spraying in claim 5 and application rates in claim 6. Grubba presents asphalt, a blend of polymers, water and emulsifier in claim 1, different emulsifiers in claims 6-9, water and emulsifier concentrations in claim 9. Harlan relates bitumen, resin and polymer in claims 1-6, bitumen emulsions in claims 12 and 19 and surfactants in paragraphs 0054-0065. Since all latices contain emulsifiers, the presence of a latex will satisfy the requirement for an emulsifier. Applicant's claims are not novel.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rostler 3,592,788, Woodruff 3,651,000, Green 4,268,428, Cummings 4,812,493, Blainpain et al. 4,997,868, Elias et al. 5,151,456, Batdorf et al. 5,330,795, Grubba 5,795,929 or Harlan 2002/0058734.

13. Cummings describes asphalt emulsions, polymers and latices in claim 1, vinyl acrylic latex in claim 11, butadiene styrene latex in claim 14 and emulsifiers, i.e. Capcure 65, in the Examples. The other references have been discussed already. Blending together members of a Markush group is obvious. The penetration is inherent in the composition, the amount applied and the soil. The application by different spray systems or mechanical mixing does not add anything to the invention. Applicant does not show any advantage or disadvantage using anionic or cationic emulsifiers or asphalt emulsions. The intended use of the applied compound has no patentable significance. There is no showing of the importance of the concentrations of the different materials, rates of dilution or means of application. A latex inherently contains applicant's claimed emulsifiers. Applicant is requested to claim his real invention, namely a blend of vinyl acrylic copolymer, styrene butadiene copolymer, emulsifier and asphalt emulsion with their respective concentrations, which would overcome the cited art. It would have been

obvious to one having ordinary skill in the art, at the time the invention was made, to change the concentrations of water and asphalt emulsion, the application rates and the penetration, according to the requirements of the application means and the soil in question.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (571) 272-1124. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Peter Szekely  
Primary Examiner  
Art Unit 1714

P.S.  
12/21/04

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